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EXAMINER

ROSSI, JESSICA

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/877,372

Applicant(s)

SCHOLZ, KONRAD

Examiner

Jessica L. Rossi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/30/03, Amendment A.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 6/30/03. Claims 8-9 were added. Claims 1-7 are pending. Claims 1-4 are withdrawn from further consideration.
2. Applicant's election with traverse of Group I, claims 5-7, in Paper No. 7 is acknowledged. The traversal is on the ground(s) that searching both groups would not be burdensome to the examiner. This is not found persuasive because as set forth in the previous office action, the pressure element could be used to practice another and materially different process wherein the pressure element is used to glue a bandlike covering to a variety of objects not limited to a board element or profile bar, which could be found in a variety of classes and their corresponding subclasses, thereby placing serious burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claim 5 stands rejected under 35 U.S.C. 102(b) as being anticipated by Finke (US 4261783; of record), as set forth in paragraph 6 of the previous office action.

With respect to claim 5, Finke, is directed to a method for applying a label 21H (bandlike covering) to a narrow face S1 of a board element or profile bar having a profiled cross-section (Figure 9) with an adhesive (column 2, lines 58-61). The reference teaches the label being pressed onto the board element or profile bar by means of at least one pressure element 201 that has an elastically deformable pressure face 232 that **deformably matches and exerts uniform**

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pressure on the shape of the board element or profile bar (**Figure 9**; column 3, lines 7-9 and 33-35; column 5, lines 15-17 and 35-39).

5. Claims 5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by La Mers (US 3823050).

With respect to claim 5, La Mers, is directed to a method for applying a label 10 (bandlike covering) to a narrow face of a board element or profile bar 72 having a profiled cross-section (Figure 10; column 1, lines 11-12; column 5, lines 20-25) with an adhesive (column 3, lines 30-33). The reference teaches the label being pressed onto the board element or profile bar by means of at least one pressure element 70 that has an elastically deformable pressure face 82 that **deformably matches and exerts uniform pressure** on the shape of the board element or profile bar (Figure 10; column 4, lines 6-7 and 19-22 and 41-43; column 5, lines 23-25 and 36).

Regarding claim 8, the reference teaches the deformable face 82 being an elastic band (Figure 10).

6. Claims 5 and 8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Wu et al. (US 6383335).

With respect to claim 5, Wu is directed to applying a flexible tape 10 (bandlike covering) to a narrow face of a board element or profile bar 12 having a profiled cross-section (Figure 1; column 2, line 51), wherein the skilled artisan reading the reference as a whole would have appreciated that the surface of the tape in contact with the board element/profile bar exhibits adhesive properties when activated by heating (column 2, lines 10-13). The skilled artisan also would have appreciated that 12 is an IC chip, which is a circuit **board element**. The reference teaches the label being pressed onto the board element or profile bar by means of at least one

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pressure element 14 that has an elastically deformable pressure face 18/20 that **deformably matches and exerts uniform pressure** on the shape of the board element or profile bar (Figures 1-4; column 1, lines 60-62; column 2, lines 58-60; column 3, lines 12-20).

Regarding claim 8, the reference teaches the deformable face 18/20 being an elastic band (Figures 1-4; column 2, lines 59-60; column 3, lines 14-18).

Regarding claim 9, the reference teaches the deformable face 18 being a spring-steel band (Figures 1-2; column 2, lines 58-60).

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 5 and 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Finke as applied to claim 5 above, and further in view of Paulk et al. (US 6529799; of record), as set forth in paragraph 7 of the previous office action.

With respect to claim 5, the examiner interpreted the Finke reference to mean that the object having surface S1 in Figure 9 was a board element or a profile bar as set forth in the 102 rejection above. It is noted that the reference does not limit the objects to any particular object.

It is known in the art to attach adhesive labels to boards in the center or at a corner of the board, as taught by Paulk (column 4, lines 1-5; column 6, lines 1-5; column 7, lines 57-63). If it is not taken that the object of Finke is a board element, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the label of Finke to a board element because such is known in the art, as taught by Paulk, and this allows for identification of the board element based on the information printed on the label.

As for the object being a profile bar, the skilled artisan would have appreciated that a profile bar is just an object having a rectangular cross-section, which is clearly depicted in Figure 9 of Finke.

Regarding claim 7, Paulk teaches the board element comprising chipboard, fiber board, or solid wood (column 4, lines 1-5).

9. Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Finke as applied to claim 5 above, and further in view of Schut et al. (US 6376058; of record), as set forth in paragraph 8 of the previous office action.

Regarding claim 6, Finke teaches the label having a pressure sensitive adhesive that is exposed once a release layer 22H is removed (column 3, lines 58-60; column 4, lines 15-18). It is known in the art to attach labels to objects using a hot-melt adhesive as an alternative to a pressure sensitive adhesive thereby eliminating the need for a release layer, as taught by Schut (column 14, lines 9-15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a hot-melt adhesive as an alternative to the pressure-sensitive adhesive of Finke because such is known in the art, as taught by Schut, and this eliminates the need for a release layer.

10. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over La Mers as applied to claim 5 above, and further in view of Paulk et al.

With respect to claim 5, the examiner interpreted La Mers to mean that the object in Figure 10 was a board element or a profile bar as set forth in the 102 rejection above. It is noted that the reference does not limit the objects to any particular type or shape (column 5, lines 20-23).

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It is known in the art to attach adhesive labels to boards in the center or at a corner of the board, as taught by Paulk (column 4, lines 1-5; column 6, lines 1-5; column 7, lines 57-63). If it is not taken that the object of La Mers is a board element, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the label of La Mers to a board element because such is known in the art, as taught by Paulk, and this allows for identification of the board element based on the information printed on the label.

As for the object being a profile bar, the skilled artisan would have appreciated that a profile bar is just an object having a rectangular cross-section, which is clearly depicted in Figure 10 of La Mers.

Regarding claim 7, Paulk teaches the board element comprising chipboard, fiber board, or solid wood (column 4, lines 1-5).

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over La Mers as applied to claim 5 above, and further in view of Schut et al.

Regarding claim 6, La Mers teaches applying the label with glue (column 3, lines 31-33). Selection of a particular type of adhesive for applying the label would have been within purview of the skilled artisan at the time the invention was made. However, it would have been obvious to attach the labels of La Mers to objects using a hot-melt adhesive as an alternative to glue because such is known in the art, as taught by Schut (column 14, lines 9-15), and one reading La Mers as a whole would have appreciated that the type of adhesive is not critical to the invention.

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over La Mers as applied to claim 5 above, and further in view of Wu et al.

Regarding claim 9, La Mers teaches the deformable face 82 being made of a flexible, resilient material but is silent as to it being a spring-steel band (column 4, lines 5-7). It is known to press a flexible tape/label onto the surface of a object using a pressure element comprising a spring-steel band, wherein the band applies uniform pressure to the tape/label to bond it to the surface of the object, as taught by Wu (see paragraph 6 above). One reading La Mers as a whole would have appreciated that the particular type of flexible, resilient material for the deformable face is not critical to the invention and therefore would have been motivated to use a spring-steel band because such is known for applying a tape/label to an object, as taught by Wu, and it allows for uniform application of pressure to the label/tape and object.

Response to Arguments

13. Applicant's arguments filed 6/30/03 have been fully considered but they are not persuasive.

14. On page 4 of the arguments, Applicants argue that the pressure element 201 does not deformably match and exert uniform pressure on the shape of the object because there are spaces between the projections of the pressure element where no pressure is applied to the object.

Although these arguments may be correct with respect to Figure 8, the examiner respectfully points that **Figure 9** clearly depicts the pressure element deforming to match the shape of the corner, or narrow face, of object S1 and exerting uniform pressure on this part of the object where the label is being applied.

Conclusion


15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **703-305-5419**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Michael W. Ball
Supervisory Patent Examiner
Technology Center 1700

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Jessica L. Rossi
Patent Examiner
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July 30, 2003